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OFFICE OF PETITIONS

ON PETITION

In re Patent No. 6,434,763 :
Issue Date: August 20, 2002 :
Application No. 09/901,359 :
Filed: July 9, 2001 :
Attorney Docket No.: 967_012 :

This is a decision on the petition filed September 7, 2011 under 37 CFR 1.181(a)(3) requesting that the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 3700 (Technology Center Director), dated July 7, 2011, which dismissed the petition indicating that the IDS did not comply with 37 CFR 1.97 and that the examiner acted properly in the matter. This decision also addresses the requested interpretation of the Rules and MPEP provisions.

The petition to overturn the decision of the Technology Center Director dated July 7, 2011, is **DENIED**.

BACKGROUND

The above cited application was allowed March 11, 2002 on first action.

Applicant submitted an Information Disclosure Statement (IDS) for consideration in this U.S. application on May 24, 2002 introducing a new reference (DE 35 22 110 A1) and a related German Office Action that presented a rejection of the claims based on that reference. This submission included an authorization to charge the necessary fee.

On June 11, 2002, before the IDS was considered, Applicant paid the issue fee in this U.S. application.

Patent No. 6,434,763 was issued on August 20, 2002 for this application.

The U.S. Patent and Trademark Office (Office) notified Patentee that the IDS did not comply with 37 CFR 1.97(d) on November 26, 2002 because the IDS lacked a statement required by 37 CFR 1.97(e) and the required fee. The IDS was placed in the official file for this patented case, but was not considered.

Patentee requested a Certificate of Correction to correct an alleged Office mistake on October 11, 2007 asking the Office to confirm that DE 35 22 110 A1, submitted with the May 24, 2002 IDS, was considered.

The Office erroneously issued the Certificate of Correction on December 11, 2007.

On January 16, 2008, the Office notified patentee that the December 11, 2007 Certificate of Correction was in error and would be vacated.

Patentee requested reconsideration of the decision to vacate the Certificate of Correction on February 12, 2008.

A new Certificate of Correction was issued on April 29, 2008 deleting the reference to DE 35 22 110 A1 made on the December 11, 2007 Certificate of Correction.

A petition under 37 CFR 1.181 was filed on May 16, 2008 to vacate the April 29, 2008 Certificate of Correction so that the December 11, 2007 Certificate of Correction was on the record as being in force.

This petition was dismissed on February 15, 2011 and indicated, among other things, that the examiner was correct in refusing to consider DE 35 22 110 A1 since the IDS lacked the required statement under 37 CFR 1.97(e) and that the examiner could not have considered the reference within the brief period between the time that the IDS was filed and the issue fee was paid.

A request for reconsideration of this decision was filed on April 15, 2011.

On July 7, 2011, this request was denied by the Technology Center Director.

LAW AND EXAMINING PROCEDURE

The following laws and procedures were published in the Manual of Patent Examining Procedure (MPEP), Original Eight Edition, August 2001, which was in effect at the time of filing the IDS.

37 CFR § 1.97 states in pertinent part:

- (d) An information disclosure statement shall be considered by the Office if filed by the applicant after [allowance], provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by:
 - (1) The statement specified in paragraph (e) of this section; and
 - (2) The fee set forth in § 1.17(p).

(e) A statement under this section must state either:

- (1) That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement; or
- (2) That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement.

37 CFR § 1.114 states in pertinent part:

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

- (1) Payment of the issue fee, unless a petition under § 1.313 is granted.

(c) A submission as used in this section includes, but is not limited to, an information disclosure statement...

37 CFR § 1.313 states in pertinent part:

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary. A petition under this section is not required if a request for continued examination under § 1.114 is filed prior to payment of the issue fee.

(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:

- (1) Unpatentability of one or more claims; which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;
- (2) Consideration of a request for continued examination in compliance with § 1.114; or

(3) Express abandonment of the application. Such express abandonment may be in favor of a continuing application.

MPEP § 609 states in pertinent part:

B(3) Information Disclosure Statement Filed After [Allowance], but Prior to Payment of Issue Fee 37 CFR 1.97(d)

An information disclosure statement will be considered by the examiner if filed on or after the mailing date of any of the following: a final action under 37 CFR 1.113; a notice of allowance under 37 CFR 1.311; or an action that closes prosecution in the application, e.g., an *Ex parte Quayle* action, but before or simultaneous with payment of the issue fee, provided the statement is accompanied by:

- (A) a statement as specified in 37 CFR 1.97(e) (see the discussion in subsection B(5); and
- (B) the fee set forth in 37 CFR 1.17(p).

These requirements are appropriate in view of the late stage of prosecution when the information is being submitted, i.e., after the examiner has reached a final determination on the patentability of the claims presented for examination. Payment of the fee (37 CFR 1.17(p)) and **submission of the appropriate statement (37 CFR 1.97(e)) are the essential elements** for having information considered at this advanced stage of prosecution, assuming the content requirements of 37 CFR 1.98 are satisfied. (emphasis added)

B(5) Statement Under 37 CFR 1.97(e)

One statement is that each item of information in an information disclosure statement was first cited in any communication, **such as a search report**, from a patent office outside the U.S. in a counterpart foreign application not more than 3 months prior to the filing date of the statement. (emphasis added)

If an information disclosure statement includes a copy of a dated communication from a foreign patent office which clearly shows that the statement is being submitted within 3 months of the date on the communication, the copy will be accepted as the required communication. It will be assumed, in the absence of evidence to the contrary, that the communication was for a counterpart foreign application.

In the alternative, a statement can be made if no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and; to the knowledge of the person signing the statement after making reasonable inquiry, neither was it known to any individual having a duty to disclose more than 3 months prior to the filing of the statement.

C(1) Noncomplying Information Disclosure Statements

Pursuant to 37 CFR 1.97(i), submitted information, filed before the grant of a patent, which does not comply with 37 CFR 1.97 and 37 CFR 1.98 will be placed in the file, but will not be considered by the Office. Information submitted after the grant of a patent must comply with 37 CFR 1.501.

The examiner should write "not considered" on an information disclosure statement where none of the information listed complies with the requirements, e.g., no copies of listed items submitted. If none of the information listed on a PTO-1449 or PTO/SB/08A and 08B form is considered, a diagonal line should also be drawn in pencil across the form and the form placed on the right side of the application file to instruct the printer not to list the information on the face of the patent if the application goes to issue. The paper containing the disclosure statement or list will be placed in the record in the application file. The examiner will inform applicant that the information has not been considered and the reasons why by using form paragraphs 6.49 through 6.49.09. If the improper citation appears as part of another paper, e.g., an amendment, which may be properly entered and considered, the portion of the paper which is proper for consideration will be considered.

If an item of information in an IDS fails to comply with all the requirements of 37 CFR 1.97 and 37 CFR 1.98, that item of information in the IDS will not be considered and a line should be drawn through the citation to show that it has not been considered. However, other items of information that do comply with all the requirements of 37 CFR 1.97 and 37 CFR 1.98 will be considered by the examiner.

OPINION

The Technology Center Director was correct to indicate that the IDS filed May 24, 2002 did not comply with 37 CFR 1.97 in that the IDS lacked the required statement under 37 CFR 1.97(e). The Technology Center Director was also correct to indicate that the

examiner acted properly and that there was no showing that the examiner did not act diligently with respect to the IDS within the brief period between the time that the IDS was filed and the issue fee was paid.

Petitioner's interpretation of 37 CFR 1.97 and its supporting discussion in the MPEP is incorrect. A statement is required for consideration of an IDS after allowance. As MPEP 609 states, such a statement is an "essential element" for having information considered at this advanced stage of prosecution. The statement may be presented in either of two forms. If the IDS includes a communication from a foreign patent office that clearly shows that the statement is being submitted within 3 months of the date on the communication, then a copy of that communication will be accepted as supporting evidence of the statement required by 37 CFR 1.97(e)(1). If the IDS does not include information cited in a communication from a foreign patent office, then, in the alternative, the statement under 37 CFR 1.97(e)(2) must be made. Either statement must be properly signed by one of the assignee, all of the inventors, or a registered practitioner. The term "communication" refers to a dated communication from a foreign patent office, not the statement under 37 CFR 1.97(e). The MPEP never refers to the statement under 37 CFR 1.97(e) in the U.S. application as a communication from a foreign patent office. Rather, MPEP 609 discusses that a communication from a foreign patent office is a document "such as a search report." This type of communication cannot serve as a replacement for the required statement as it is supporting evidence of the statement and is not properly signed in the U.S. application as required for the statement. That is, a statement under 37 CFR 1.97(e)(1) is required when an IDS is presented after allowance with a communication from a foreign patent office, and a copy of that communication from a foreign patent office may be submitted to show the timeliness of the statement.

Here, the after allowance IDS filed May 24, 2002 included an Office Action that cited a German reference and was dated less than 3 months before submission of the IDS. That German reference was the only reference cited on the after allowance IDS. The foreign Office Action is a communication from a foreign patent office and a statement under 37 CFR 1.97(e)(1) was required. No statement was made. Accordingly, the reference was not considered by the Office and has not been considered by the Office to date.

In addition, MPEP 609 C(1) provides guidance to the examiner as to how Applicant should be notified when an IDS does not comply with governing regulations. Although these procedures are preferred, they do not preclude the Office from giving Applicant notice in the manner used in this case. The Office provided notice of non-compliance approximately 6 months after the IDS was filed, and there is no time limit within which the Office must act. Moreover, Applicant paid the issue fee less than one month after the IDS was filed, which had the effect of withdrawing this application from consideration by the examiner and initiating the process of preparing the patent for

issue. The patent was issued promptly after Applicant paid the issue fee. There is no evidence of record to suggest that either the Office or the examiner acted without diligence in processing the non-compliant after allowance IDS. Rather, the record suggests that the IDS was processed in a timely manner and with appropriate diligence by the Office.

Failure of Applicant to receive Notice of non-compliance within a shorter period of time does not justify a conclusion that the IDS was compliant or that the Office was not diligent in processing the IDS. This is because Applicant did not give the Office sufficient time to provide such notification prior to issuing the patent and notice was given by the Office within a reasonable period. Also, a lack of diligence by the Office in processing the IDS would not relieve Applicant of the legal obligation to comply with 37 CFR 1.97. The after allowance IDS was not compliant and was not considered.

If Applicant wanted to ensure that the Office had sufficient time to consider the IDS, Applicant could have withdrawn the application from issue pursuant to 37 CFR 1.313. By submitting a Request for Continued Examination (RCE) under 37 CFR 1.114, with the IDS as the required RCE submission, rather than paying the issue fee, the application would have been withdrawn from issue under 37 CFR 1.313(a). Even after the issue fee was paid, the application could have been withdrawn from issue under 37 CFR 1.313(c) by filing a grantable petition in addition to the RCE.

The salient issue in this case is not the timeliness or the manner in which petitioner was notified of the non-entry of the IDS. This is true because neither the Statute, Rules nor MPEP set forth a time period in which the Office must respond to an IDS submitted after a Notice of Allowance. Rather, the issue is whether or not petitioner complied with the rules governing the proper submission of an IDS, *e.g.*, 37 CFR 1.97, in effect at the time of filing the IDS on May 24, 2002. Under the rules in effect then, failure to submit an IDS in compliance with the rules precludes its consideration. Unfortunately, the IDS filed May 24, 2002 was not accompanied by an appropriate statement under 37 CFR 1.97(e) and thus, the refusal to consider the IDS was proper.

DECISION

A review of the record indicates that the Technology Center Director did not abuse her discretion or act in an arbitrary and capricious manner in the petition decision of July 7, 2011. The record establishes that the Technology Center Director had a reasonable basis to support her findings and conclusion.

The petition is granted to the extent that the decision of the Technology Center Director of July 7, 2011 has been reviewed, but is denied with respect to making any change

therein. As such, the decision of July 7, 2011 will not be disturbed. The petition is **denied**.

This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

Telephone inquiries concerning this decision should be directed to Christopher Bottorff at (571) 272-6692.

A handwritten signature in black ink, appearing to read "Andrew Hirshfeld", is written over the printed name.

Andrew Hirshfeld
Deputy Commissioner for
Patent Examination Policy

ak/db